



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------------------------------------------------------|-------------|-----------------------|----------------------------|------------------|
| 10/821,548 | 04/09/2004 | Robert Harold Bateman | AE-MM-11 (MST-1237 US2) | 1303 |
| 7590 | 12/13/2005 | | EXAMINER | |
| Anthony J. Janiuk Waters Corporation 34 Maple Street Milford, MA 01757 | | | SOUW, BERNARD E | |
| | | | ART UNIT | PAPER NUMBER |
| | | | | 2881 |

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AKC

| | | |
|------------------------------|-----------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/821,548 | BATEMAN ET AL. |
| | Examiner Bernard E. Souw | Art Unit 2881 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on Transmittal 04/09/2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 1-124 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 April 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/7/05+8/23/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-58 and 63-120, drawn to a mass spectrometry method, classified in class 250, subclass 282.
 - II. Claims 59-62 and 121-124, drawn to mass spectrometer with ion source, classified in class 250, subclass 285-300.
2. Claims 1-58 are method claims that are disguised as apparatus claims by declaring a mass spectrometer, wherein the claims limitations are functional languages that are very similar or almost identical to mass spectrometry method recited in claims 63-120. Therefore, claims 1-58 and 63-120 are considered as mass spectrometry method claims, to be distinguished from mass spectrometer apparatus claims.
3. Inventions I (mass spectrometry method) and II (mass spectrometer apparatus) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination (functional language “*to determine*” or method steps of “*determining a mass to charge ratio ... etc.*”) as claimed in claims 1-58 and 63-120 (group I) does not require the particulars of the subcombination (ion source types) as claimed in claims 59-62 and 121-124 (group II), because the mass spectrometry

method recited in claims of group I may be performed using ion source types fully different from group II. The subcombination (mass spectrometer + ion source types as in 59-62 and 121-124) has separate utility such as an ion implant system that does not need a processing method recited in claims 1-58 and 63-120.

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Priority

5. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), (GB 0308278.1), filed 04/10/2003, which papers have been placed of record in the file.

Information Disclosure Statement

6. Receipt is acknowledged of information disclosure statements (IDS) submitted on 10/07/2005 and 08/23/2004. The submission is in compliance with the provisions of 37 CFR 1.97.

Signed copies of the information disclosure statements are here enclosed.

Communications

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernard E Souw whose telephone number is 571 272

Art Unit: 2881

2482. The examiner can normally be reached on Monday thru Friday, 9:00 am to 5:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R Lee can be reached on 571 272 2477. The central fax phone number for the organization where this application or proceeding is assigned is 571 273 8300 for regular communications as well as for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571 272 5993.

Bes

December 11, 2005


JOHN R. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800